UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _29 October 2008_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-17_ is/are pending in the application.

    4a) Of the above claim(s) _12-16_ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-11 and 17_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _4/28/2005_.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   Claims 1-17 are pending.

2.   Claims 1-11 and 17 have been examined.

3.   This Office action is given Paper No. 20090115 for reference purposes only.

Election/Restrictions

4.   Applicant's election without traverse of claims 1-11 and 17 in the reply filed on 28

October 2008 is acknowledged.

Examiner's Comments

5.   Applicant's claims employ language that does not serve to differentiate the

claims from the prior art.

6.   Claim 1 recites "...a plurality of local terminals...*suitable for* issuing said printed

objects, said central unit *being suitable for* controlling said local terminals..." and "...said

smart cards being provided *for being used* by said operators to activate and enable said

local terminals..." (emphasis added). This language recites the intended use of the

system and therefore does not serve to differentiate the claim from the prior art. While

features of an apparatus may be recited either structurally or functionally, claims

directed to an apparatus must be distinguished from the prior art in terms of structure

rather than function alone (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re*

Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)).

7.   Claim 1 further recites "...wherein said initialization program is such as to initialize in combination, during an initialization stage, a given local terminal and a given smart card, so as to establish between said given terminal and said given smart card a bi-unequivocal relationship of correspondence and cooperation, such that, following said initialization stage, said given smart card is enabled to be used on and to cooperate solely with the corresponding said given terminal, and in turn said given local terminal is enabled for issuing said printed objects solely after having recognized said given smart card, in combination with which it was initialized." However, as this describes software stored in memory but not executed, it is nonfunctional descriptive material and does not serve to distinguish the claim from the prior art. Further, claim 10 recites "...wherein said printed objects are selected from the group consisting of postage stamps, revenue stamps, stamped titles, labels, and similar prints." However, as this only describes printed objects that the system of claim 1 is capable of issuing, it is nonfunctional descriptive material as the type of printed object issued does not affect the system. Nonfunctional descriptive material does not serve to distinguish the claims from the prior art. It has been held that where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

Claim Rejections - 35 USC § 112

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

9.   Claims 1-11 and 17 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

10.   Claim 1 and 17 recite the limitation "the land" in line 4 of the claims. There is

insufficient antecedent basis for this limitation in the claims.

        Claims 2-11 are also rejected as each depends from claim 1.

11.   Claims 1-11 are rejected as failing to define the invention in the manner required

by 35 U.S.C. 112, second paragraph.

        The claim(s) are narrative in form and replete with indefinite and functional or

operational language. They appear to be a literal translation into English from a foreign

document. The structure which goes to make up the device must be clearly and

positively specified. The structure must be organized and correlated in such a manner

as to present a complete operative device.

12.   Regarding claim 1, the phrases "such as" and "such that" render the claim

indefinite because it is unclear whether the limitations following the phrase are part of

the claimed invention. See MPEP § 2173.05(d).

        Claims 2-11 are also rejected as each depends from claim 1.

13.   The terms "suitable", "throughout the land", and "solely" in claims 1 and 17 are

relative terms which renders the claims indefinite. The term terms "suitable",

"throughout the land", "such that", and "solely" are not defined by the claims, the

specification does not provide a standard for ascertaining the requisite degree, and one

of ordinary skill in the art would not be reasonably apprised of the scope of the

invention. These terms render the description of the plurality of local terminals and the

relationship between the smart cards and local terminals indefinite.

Claims 2-11 are also rejected as each depends from claim 1.

14.   Claims 2-7 make reference to multiple statutory classes of invention. Specifically,

claims 2-4 and 6 are directed to a system; however, they recite method steps. Claim 2

recites "...activating...recording...and signing...", claim 3 recites "...the execution of said

initialization program is preceded by a *customization* step..." (emphasis added), claim 4

recites "...recording...", and claim 6 recites "...activating...modifying..." A claim that

purports to be within multiple statutory classes is ambiguous and is properly rejected

under U.S.C. 112, second paragraph, for failing to particularly point out and distinctly

claim the invention (*Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

Claims 5 and 7 are also rejected as each depends from claim 2.

Claim Rejections - 35 USC § 103

15.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

16.   Claims 1, 8-11, and 17 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Wright et al. (US Patent No. 4,802,218, hereinafter "Wright").

17.   Regarding claim 1, Wright discloses a method and distributed system suitable for

issuing printed objects, comprising:

- providing a central control unit (Wright **18:43-50**);

- providing a plurality of local terminals distributed throughout the land and suitable

   for issuing said printed objects, said central unit being suitable for controlling said

   local terminals through a communication and control network (Wright **8:37-40**;

   9:9-16; **17:63-18:5**);

- providing a plurality of smart cards assigned to the operators of said local

   terminals, said smart cards being provided for being used by said operators to

   activate and enable said local terminals to issue said printed objects (Wright **6:5-

   39**; **17:63-68**);

- initializing, using an initialization program, in combination a given local terminal of

   said plurality of local terminals and a given smart card of said plurality of smart

   cards; (Wright **6:40-63**; **8:37-47**; **16:39-59**); and

- establishing a bi-unequivocal relationship of correspondence and cooperation

   between said given terminal and said initialized given smart card (Wright **6:40-63**

   8:37-47, 53-65; **9:12-16**; **16:47-59**), including:

- enabling said initialized given smart card for use on and cooperation with the

   corresponding given local terminal in combination with which it was initialized

   (Wright **8:53-65**; **9:9-16**; **16:47-59**), and

- enabling said given local terminal to issue said printed objects after having

  recognized said initialized given smart card (Wright **8:37-47**, **53-65**; **9:12-16**).

Wright further discloses that the terminals in a company can have a machine ID number

assigned to them, and the cards issued to the employees of that company can be

initialized so that the terminals within the company can only be used with those cards.

Also, a card can be restricted for use only on certain machines (Wright **8:53-65**; **9:9-16**;

16:47-59).

Wright does not explicitly disclose that only one card may necessarily be used

with only one terminal, and only one terminal may necessarily be used with only one

card.

However, a predictable result of limiting the use of a company or department's

terminals to cards issued to employees of that company or department would be to

have a terminal that can only be used with one card in the case where the company or

department only had a single terminal with only one employee authorized to print

postage. Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to use the system of Wright to establish a one-to-one relationship

between a single card and a single terminal. (*KSR International Co. v. Teleflex Inc.*, 82

USPQ2d 1385 (U.S. 2007))

18.   Regarding claim 8, Wright does not specifically disclose that said initialization

program is installed on each of the local terminals of said system and constitutes a

machine program true and proper, protected and non-modifiable, for each local

terminal.

However, as this only describes the location of data stored in the system, it is nonfunctional descriptive material and does not serve to distinguish the claims from the prior art. It has been held that where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability …. [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

19.   Regarding claim 9, Wright discloses that the execution of said initialization program is proposed by the system in response to the insertion of a smart card not yet initialized in a respective local target terminal (Wright **16:45-59**).

20.   Regarding claim 10, Wright discloses that said printed objects are selected from the group consisting of postage stamps, revenue stamps, stamped titles, labels, and similar prints (Wright **7:20-23**).

21.   Regarding claim 11, Wright discloses the system according to claim 1 wherein said given local terminal and the corresponding given smart card are provided for controlling autonomously, without the intervention of said central control unit, the execution of local operations concerning the issuing of said printed objects, and wherein said given local terminal is provided for periodically transferring to said central control unit data inherent in said local operations (Wright **7:52-8:2**; **9:25-42**; **10:53-62**; **11:53-12:22**; **18:43-50**).

22.   Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Wright in view of Cordery (US Patent Application Publication No. 20030097336).

23.   Regarding claim 2, Wright discloses wherein said initialization program is

provided for being executed following the insertion of said given smart card in the

corresponding given local terminal (Wright **7:47-51**; **8:66-9:3**). Wright further discloses

storing a secret key number on a user's smart card (Wright **4:37-41**; **6:46-54**; **8:58-65**).

Wright does not specifically disclose that the initialization program is provided for

activating the following steps: recording in a given string an "in the clear" code and an

invisible or protected code relative to said given local terminal so as to obtain

information or a fingerprint defined unequivocally by said given local terminal; and

signing said fingerprint of said given local terminal with a secret key present on said

given smart card, so as to generate a signed fingerprint to be sent to said central control

unit.

Cordery discloses a program provided for activating the following steps:

recording in a given string an "in the clear" code and an invisible or protected code

relative to said given local terminal so as to obtain information or a fingerprint defined

unequivocally by said given local terminal (Cordery Paragraphs **8**, and **12-13**); and

signing said fingerprint of said given local terminal with a secret key, so as to generate a

signed fingerprint to be sent to said central control unit (Cordery Paragraph **13**).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to modify the system of Wright to include registering information

with a remote data processing center using an encrypted string comprising a serial

number and a secret key as disclosed in Cordery in order to allow secure transmission of updated keys used in a postage meter to the data processing center (Cordery Paragraph **3**).

24.   Regarding claim 3, Wright discloses that the execution of said initialization program is preceded by a customization step, the purpose of which is to associate and customize said given smart card with a given account provided within the framework of said system (Wright **6:40-63**, **6:64-7:13**; **9:12-16 16:45-59**).

25.   Regarding claim 4, Cordery discloses that the execution of said initialization program is subordinated to the recording in a memory of said given local terminal of said "in the clear" code and of said protected code (Cordery Paragraphs **8** and **12**).

26.   Regarding claim 5, Wright discloses that the execution of said initialization program determines the enablement of said given smart card within the framework of said system, in association with said given local terminal with which said given smart card has been initialized (Wright **6:40-63**; **9:9-16**). Wright further discloses that the smart card stores account data (Wright **6:64-7:13**; **16:45-59**)

Wright does not specifically disclose that the execution of said initialization program determines the recording of said given smart card on said central control unit.

Cordery discloses a postage meter that stores account information such as register values in a non-volatile memory on the postage meter (Cordery Paragraph **8**). Cordery also discloses registering information related to a particular postage meter with a remote data processing center (Cordery Paragraphs **8**, and **12-13**).

A predictable result of storing account information on a smart card as opposed to on the postage meter, in a system where information is registered with a remote data processing center, would be to register information related to the smart card with the remote data processing center as opposed to the postage meter. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Wright in view of Cordery to include recording information related to a smart card on the central control unit. (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007))

27.   Regarding claim 6, Wright discloses that said initialization program is further provided for activating the following step: modifying a given data string recorded on said given smart card and normally employed for defining a personal identification code (PIN) of the holder of said smart card, so as to inhibit the availability of said personal identification code (PIN) to the user of said smart card (Wright **6:32-35**; **45-57**; **9:12-16**; **16:51-52**, **57-59**).

28.   Regarding claim 7, Cordery discloses that said initialization program executes the signature of the fingerprint of said given local terminal by using an encryption algorithm (Cordery Paragraph **13**).

Wright in view of Cordery does not specifically disclose that the signature of the fingerprint is executed using a so-called double, asymmetric key algorithm.

However, a predictable result of using an encryption algorithm to generate a signature would be to use any well-known encryption algorithm, including a double asymmetric key algorithm. Therefore, it would have been obvious to one of ordinary skill

in the art at the time of the invention to modify the system of Wright in view of Cordery

to employ a double asymmetric key algorithm. (*KSR International Co. v. Teleflex Inc.*,

82 USPQ2d 1385 (U.S. 2007))

Conclusion

29.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

- US Patent No. 4,980,542 to Jackson et al. for disclosing restricting the use of a

  postage meter to designated accountable entities.

- US Patent Application Publication No. 20020165835 to Igval for disclosing

  registration of accounts associated with a particular customer and meter in a

  central database.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MOHAMMAD NILFOROUSH whose telephone number

is (571)270-5298. The examiner can normally be reached on Monday-Thursday 8 am -

5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. N./
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685